

Frequently Asked Questions about Geographical Indications (GIs)

What are geographical indications?

The term “geographical indication” comes from the World Trade Organization’s Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). The TRIPS Agreement sets forth standards to regulate international intellectual property protection and enforcement and establishes international minimum standards for the protection of geographical indications.

<http://www.uspto.gov/web/offices/dcom/olia/globalip/trips.htm>

Geographical indications are defined as “indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographic origin.”

This means that a geographical indication (or “GI”) is a sign used to indicate the regional origin of particular goods/services and that there must be a link between some characteristic of the good and the particular region where it was produced. For example, the Florida Sunshine Tree is a symbol known to consumers that links citrus products featuring the Sunshine Tree to Florida where the distinctive-tasting citrus is grown.

Are GIs just place names?

A GI can be a geographic place name (*e.g.*, “Napa Valley”) but it may also be a symbol (*e.g.*, a picture of the Eiffel Tower, the Statue of Liberty, an orange tree),



or the outline of a geographic area (*e.g.*, the outline of the state of Florida or a map of the Dominican Republic),



a color, or anything else capable of identifying the source of a good or service.

When I see **MADE IN CHINA** on a t-shirt, is that a GI?

Probably not, but it really depends. For an indication to function as a GI, there must be a link between some characteristic of the good and the particular region where it was produced. That link must inform consumers of some important characteristic of the product that is material in their decision to purchase the good.

Not every indication can rise to the level of a GI. In other words, a geographic name itself is not a GI. In order for a geographic name to function as a GI, it must indicate more than just origin; it must communicate that the product from this region has a particular quality or has a particular reputation. The source-indicating capacity of a GI is key, and highlights the distinction between a GI and a mere geographic term that does not function as source-identifier.

Does the USPTO have a GI register or a list of GIs?

The United States Patent and Trademark Office (USPTO) does not have a special register for GIs in the United States. The United States has protected marks that are geographical indications through the trademark system for decades, long before the term "geographical indications" came into use in 1995 with the negotiation of the World Trade Organization (WTO) Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). Our trademark register contains GIs registered as trademarks, certification marks and collective marks and these are not designated with any special field as "geographical indications." Because of the flexible protection offered through U.S. trademark law for all marks, including those that meet the WTO TRIPS definition of a "geographical indication," USPTO does not identify marks as GIs and does not examine marks on that basis. USPTO does examine whether the mark functions as a source identifier to the United States consuming public, the same analysis as for a trademark.

Does the United States have any GIs?

Yes. The United States has many valuable geographical indications that have been in use in the United States for decades. Names like IDAHO POTATOES, or FLORIDA ORANGES, or VIDALIA ONIONS, or NAPA VALLEY WINES, or WASHINGTON STATE APPLES have been used in the United States and are protected under U.S. trademark laws against unfair competition and trademark infringement, whether or not they are registered with the USPTO. Moreover, many foreign GIs are protected in the United States via the geographical indication certification mark system. Examples include:

BRUNELLO DI MONTALCINO (U.S. Reg. No. 1,860,163) – **Italy**
COGNAC (Common-law, unregistered geographical indication certification) – **France**
LIEBFRAUMILCH (U.S. Reg. No. 1,008,251) – **Germany**
MOSEL (U.S. Reg. No. 1,008,252) – **Germany**
VINO NOBILE DI MONTEPULCIANO (U.S. Reg. No. 2,251,165) – **Italy**
DARJEELING (U.S. Reg. No. 2,685,923) – **India**
JAMAICA BLUE MOUNTAIN COFFEE (U.S. Reg. No. 1,414,598) – **Jamaica**

Anyone can view these entries in the USPTO Trademark Electronic Search System (TESS) at <http://www.uspto.gov/index.html> under "Trademarks" and then "Search" using the registration numbers or marks themselves.

While registration is not necessary to establish rights in the United States, owning a federal trademark registration on the Principal Register provides several advantages, e.g.,

- constructive notice to the public of the registrant's claim of ownership of the mark;
- a legal presumption of the registrant's ownership of the mark and the registrant's exclusive right to use the mark nationwide on or in connection with the goods/services listed in the registration;
- the ability to bring an action concerning the mark in federal court;
- the use of the U.S. registration as a basis to obtain registration in foreign countries; and
- the ability to file the U.S. registration with the U.S. Customs Service to prevent importation of infringing foreign goods.

Should I start using the name of my town or county to market my goods/services?

Just as you carefully choose (with the assistance of legal counsel in most cases) a trademark to use on your goods/services, you should also carefully consider the value of using a geographic term on your products to distinguish them from the same or similar products being manufactured elsewhere. If you believe that consumers would be interested in buying your products because they come from a particular area, you may very well benefit from using a geographic term to identify your goods/services. You may wish to consult with an experienced intellectual property attorney to determine the feasibility of using a geographic term and the potential pitfalls to avoid, including conflicts with any pre-existing rights of others in that term.

Geographical indications are becoming increasingly important, as they are key features on many agricultural and food product labels and are valuable assets that play an integral role in promoting trade and consumer interests. Like trademarks, GIs are valuable marketing tools, where a company's/producer's good-will and reputation are linked to its products. U.S. businesses and producers should be aware of the value of these marketing tools and should look into the avenues of protecting these business interests from infringement by others.

When I applied for a trademark registration with the USPTO for a geographic term, my application was refused as geographically descriptive. How can I get protection if I cannot even register the geographic term?

Under U.S. trademark law, geographic terms or signs are not registrable as trademarks if they are geographically descriptive or geographically misdescriptive of where the goods/services originate. The theory is that other producers in that area would need to be able to use a geographic term to describe where their goods/services are from and that one person should not be able to prevent others from using that term. If a term is

misdescriptive for the goods/services, consumers would be misled and/or deceived by the use of the term on goods/services that do not come from the place identified.

However, a geographical indication, as defined in TRIPS, identifies a good, not merely a geographic area. If a geographic term is used in such a way as to identify the source of the goods/services and, over time, consumers start to recognize it as identifying a particular company or manufacturer or group of producers, the geographic term no longer describes only where the goods/services come from, it also describes the "source" of the goods/services. We say that the term has "secondary meaning" or "acquired distinctiveness." The primary meaning to consumers is the geographic place, whereas the secondary meaning to consumers is the producing or manufacturing source. If a descriptive term has "secondary meaning" to consumers, the term has a source-identifying capacity and is protectable as a trademark. Because of this feature of U.S. trademark law, geographical terms or signs can also be protected as trademarks or collective marks.

Geographical terms can also be protected as certification marks. A geographical term may be used, either alone or as a portion of a composite mark, to certify that the goods/services originate in the particular geographical region identified by the term. The U.S. Trademark Act excepts indications of regional origin from the prohibition against registration of names that are primarily geographically descriptive. Therefore, a geographical name may be registered as a certification mark even though it may otherwise be primarily geographically descriptive and hence unregistrable as a trademark in the absence of secondary meaning.

For more information about how the USPTO handles applications for collective marks and certification marks, consult the Trademark Manual of Examining Procedure (TMEP) Chapter 1300 at <http://www.uspto.gov/web/offices/tac/tmep/1300.htm> For information about USPTO examination of geographically descriptive and misdescriptive marks, consult TMEP Section 1210 at http://www.uspto.gov/web/offices/tac/tmep/1200.htm#_Toc98817860.

What protection do GIs get in the United States?

As for the protection given to GIs in the United States, U.S. law provides that the trademark (GI) owner has the exclusive right to prevent confusing uses of the mark by unauthorized third parties. See 15 USC 1114 and 1125.
<http://www.uspto.gov/web/offices/tac/tmlaw2.html>

If someone registers the name of my town as a GI, can I still use it to describe where my goods/services come from?

If someone registers the name of a place as a trademark, certification or collective mark for a particular good or service, that registration does not necessarily prevent anyone else from using the term on unrelated goods/services provided the U.S. consuming public is not likely to be confused as to the source of the goods/services. A trademark,

certification mark or collective mark is not a monopoly right. The property right (the right to exclude others from using it and confusing the public) exists for these marks only in relation to a specific set of goods/services. The right extends to similar, related, or even unrelated goods/services depending on the specific factors of each case. A very well-known mark will have a wider scope of protection against infringing uses than a mark that is not known very well at all; the test is whether the average U.S. consumer would likely be confused as to the source of the goods/services between the two uses of the mark.

Moreover, a trademark, certification mark or collective mark registration does not necessarily prevent someone from using the term to fairly describe where their goods/service originate when their goods/services are the same as those identified in the registration. Such use may be considered a fair use of descriptive terms. Fair use, as it is recognized in the United States, is a defense to a claim of trademark infringement. This concept developed very early on in U.S. jurisprudence as courts recognized that trademark law should not be able to take words entirely out of the public domain.

However, to qualify for the fair use defense, use of a term must be purely descriptive and to determine if the use is purely descriptive, there must be an evaluation of how the term is used in the marketplace. If the term is used in a way that can be confusing to the public as to the source of the goods/services, then the use is not really “fair” and the mark owner could take a trademark infringement action against the use.

If someone registers a GI as a certification mark and I meet the standards, can I use the GI on my goods/services?

Yes, if the certification mark owner certifies your goods/services as meeting the standards. If your goods/services meet the standards but are not certified by the owner, you cannot use the term. The owner must be able to control the use of the term on the goods/services. If the owner cannot do that or does not do that, the mark is subject to cancellation. If the owner discriminates against a producer who actually meets the standards, the mark is also subject to cancellation.

USPTO requires the certification mark applicant to submit a copy of the certification standards and retains those as part of the official record. USPTO examines all applications for certification marks. The accompanying specimens of use and evidence in the record are reviewed to determine whether the geographical term is being used as a certification mark to indicate the geographical origin of the goods/services upon which it is used.

With certification marks, the ability of the certification mark owner to "exercise legitimate control" over the use of the term by others is a critical issue. Often, a government or municipality is in the best position to control the use of a term by a group of producers. But a private association or agricultural collective is also in a good position to control the use of the term by producers. Either entity, a government or a private association, is acting as a private rightholder as the owner of the GI, a private right. In

that way, the U.S. GI regime is consistent with the TRIPS Agreement, which says that intellectual property rights are "private rights."

USPTO's opposition and cancellation system allows interested third parties to object to an application or registration before the USPTO's Trademark Trial and Appeal Board (TTAB) to ensure that the certification standards are being met. Here is the link to the USPTO's TTAB website: <http://www.uspto.gov/web/offices/dcom/ttab/>

For further inquiries, please contact Amy Cotton of the USPTO's Office of International Relations (External Affairs) at amy.cotton@uspto.gov or (571) 272-8467.